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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,388	05/25/2001	Mary Kay Bitton	212/332	4199
23371	7590	08/27/2004		
CROCKETT & CROCKETT 24012 CALLE DE LA PLATA SUITE 400 LAGUNA HILLS, CA 92653			EXAMINER LECHERT JR, STEPHEN J	
			ART UNIT 1732	PAPER NUMBER

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,388

Applicant(s)

BITTON, MARY KAY

Examiner

Stephen J. Lechert Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2004 has been entered.

2. The examiner acknowledges the RCE and further notes that no amendments have been made to the claims.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a

background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.**
 - 2. Ascertaining the differences between the prior art and the claims at issue.**
 - 3. Resolving the level of ordinary skill in the pertinent art.**
 - 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**
- 5. Claims 1-4 and 7-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McCook in combination with Conrad.**

McCook teaches the invention substantially as claimed. McCook teaches a method of using a hand held device for imprinting images in soft surfaces, specifically sand. The device can be placed on a child's foot or can be hand held for imprinting images in a soft surface or sand.[Note the abstract and Figures 10a-10d] The device includes raised or protruding indicia printed pads which can imprint various designs into the soft surface or sand as shown in Figures 3 and 3A. The indicia pads(13) includes structure which is equivalent in function to applicant's detail and silhouette blades (or sidewall) by providing a imprint on a soft surface such as sand or soft ground which will impart to the sand or soft ground the indicia or imprint as depicted in Figure 5

wherein a raised portion or protrusion is provided when the pad is either pressed into the soft ground or sand either by hand or by using one's foot.

However, McCook does not teach applicant's specific detail with respect to the detail blade thickness, spacing and depth.

Conrad teaches a dough or cookie cutter having a hand for grasping by the user which has a rigid cutting wall with a sharp cutting edge. The dough or cookie cutter includes an outer cutting element which cuts the silhouette shape and further includes detail blades which extend from the base member and provides the imprint in the dough. The dough cutter includes detail blade which have a height less than the height of the circumferential silhouette blade so that the cutter will not only cut the shape of the figure from the dough but will also provide details or protrusions within the dough imparting an intricate design to the dough.

McCook teaches an imprinting device for soft surfaces such as sand. The imprinting device includes raised indicia pads which imprints a soft surface creating a raised design in the sand or soft

ground. Conrad teaches a cookie cutter or dough cutter which is a die cutter, Conrad teaches cutting a soft surface such as a dough with a cutter or die which includes silhouette blades as well as detail blades which extend from the base member and can not only cut the dough into a desired shape but further include within the cut dough details, the detail blades have a high less than the height of the silhouette blades and provides a very detailed image of a design when pressed into a soft surface such as dough.

It would have been obvious from the combined teachings of McCook and Conrad to provide a die which cuts into the surface of the sand to leave an imprint in the sand. Both references teach imprinting or cutting a soft surface which would read on sand or snow or dough. McCook specifically teaches imprinting soft ground or sand using an imprinting pad which is either hand held or can be used with feet. Conrad teaches providing a cookie cutter or die cutter which can imprint as well as cut a soft surface such as dough. The cookie cutter or die cutter includes a silhouette blade as well as detail blades. The reference of Conrad teaches that the detail blades has a height less

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than the height of the silhouette or peripheral cutting blade, so that the details blade cut the surface of the soft surface, e.g. dough to impart details to the design but does not cut all the through the dough.

Admittedly, the references do not teach the height, the depth the thickness the spacing as recited, however, these aspects details of the die cutter as claimed would have been obvious from the teachings of both McCook and Conrad because applicant's basic concept of imprinting a soft surface such as sand or snow has been taught by the prior art. The prior art does teach providing details of the imprint, to provide me definition to the details it would have been obvious to one ordinary skill in art at the time the invention was made, especially in light of Conrad who teaches using different height details blades to provide a more defined imprint. It is maintained that to the ordinary artisan, that a sharp or crisper image would be achieved by engineering the detail blades to achieve the optimum image or imprint.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is

in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the imprinter of McCook does suggest using a die to imprint soft material such as ground or sand, the imprinting device would suggest to one of ordinary skill in the to use some other type of die such as a cookie to imprint or outline

design or figure in a soft material such as sand, snow or dough. The secondary reference is a die or cookie cutter that provides a more sophisticated detail which not only cuts the dough but also impresses or imprints detail of the interior detail on the surface of the cut dough. The references in combination do suggest to one of ordinary skill in the art, applicant's invention. The gist of the invention is drawn to a method of imprinting sand or snow with a die to leave an imprint therein. Clearly, this step is shown in both McCook and Conrad. Even though the above references may not produce a sharp imprinted image in the sand or snow as applicant's because the blade definition is not taught, this feature was suggested in Conrad to provide detail blades and the engineering or perfection of the design of the details does not lend patentability to the process of imprinting sand even though the applicant's die provides a better image in the sand or snow.

8. With respect to applicant's request from the examiner to provide a signed affidavit which indicates his children and other people at the beach have imprinted sand with cookie cutters. The examiner will reserve his right to produce such affidavit if and when this case would

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go for appeal. Applicant is advised the affidavit merely will state to his best knowledge and recollection that his children, the oldest of which is 34 years old has used cookie cutters playing at the beach in Ocean City, Maryland.

9. This is a RCE of applicant's earlier Application No. 09/865,388.

All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

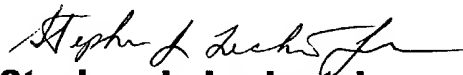
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 571-272-1203. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen J. Lechert Jr.
Primary Examiner
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